

REMARKS

Claims 1, 3, 11, 13, and 19 remain pending in the present application. In response to the Final Office Action (hereinafter "Action") dated April 21, 2006, Applicant respectfully requests reconsideration and allowance of the subject application based on the following remarks.

Applicant's remarks after Final Office Action are appropriate under 37 C.F.R. §1.116 because they address the Office's remarks in the Final Office Action, and thus could not have been presented earlier. In addition, the remarks should be entered to place the application in better form for appeal.

Interview Request

After receiving the Final Action, Applicant requested an interview, but the Applicant's request was denied because the instant application is under Final Action. Nevertheless, after consideration of the remarks herein, if any issue remains unresolved that would prevent allowance of this case, the Examiner is **requested to contact the undersigned attorney** to resolve the issue.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1, 3, and 19 stand rejected under 35 U.S.C. §102(b), as allegedly anticipated by U.S. Patent No. 5,738,654 to Tihon. Applicant respectfully traverses this rejection. Anticipation under §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (MPEP §2131).

Independent Claim 1, which is directed to a fish tape, recites in part:

"a longitudinal portion comprising a circular outer diameter, wherein the circular outer diameter ranges from about 0.1875 inches to about 0.375 inches; defining a substantially cylindrical shape along the longitudinal portion of the fish tape, wherein the substantially cylindrical shape comprises a plurality of spiral grooves defined along the circular outer diameter and extending along the longitudinal portion; and

an end portion comprising a spiral groove extending from the end portion partially along the longitudinal portion, wherein the spiral groove provides one or more mechanisms for attachment."

In setting forth a ground of rejection, the Office cited Figure 5 of Tihon, an elongate plastic member having an outer diameter of 0.21 inches and a plurality of spiral grooves (see Action, page 2). For convenience, Applicant reproduces here Figure 5 of Tihon:



FIG. 5

This evidence does not disclose expressly or inherently "a circular outer diameter" and "an end portion comprising a spiral groove extending from the end portion partially along the longitudinal portion, wherein the spiral groove provides one or more mechanisms for attachment", as recited in Claim 1. The Office cited Figure 5 showing a fragmentary view of the bladder drain with two channels 20 emptying urine through the lumen 18. Tihon is a drainage device which includes a bladder retaining portion 22, a drain body 12, a fluid collection segment (tubular) 24 which collects fluid from the channels into a bag or a plug at the end, and a loop 27 (shown in Fig. 1). Thus, Tihon does not disclose the features recited in Claim 1.

Furthermore, the Office stated the device is capable of performing the intended use recited in the claims, i.e., is capable of functioning as a fish tape (Action, page 2). Applicant respectfully disagrees. Tihon is not capable of functioning as a fish tape because Tihon does not disclose an end portion comprising a spiral groove for providing one or more mechanisms for attachment.

Therefore, Tihon does not anticipate independent Claim 1. Because **dependent Claim 3** depends on Claim 1, the comments directed to Claim 1 apply equally to Claim 3.

Independent Claim 19 has features similar to Claim 1 and hence benefits from the same arguments directed above to Claim 1. Applicant asserts Tihon fails to anticipate independent Claims 1 and 19 because Tihon does not disclose the recited features of the claimed subject matter. Accordingly, Applicant requests withdrawal of the §102 rejections of these claims.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 11 and 13 stand rejected under 35 U.S.C. §103(a), as allegedly unpatentable over Tihon. Obviousness under §103 requires (i) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (ii) a reasonable expectation of success and (iii) that the prior art reference (or references when combined) must teach or suggest all the claim limitations (MPEP §2143).

Independent Claim 11, which is directed to a fish tape device, recites in part:

*"a fish tape comprising
a longitudinal portion comprising a circular outer diameter, wherein the circular
outer diameter ranges from about 0.1875 inches to about 0.375 inches; defining a*

substantially cylindrical shape along the longitudinal portion of the fish tape, wherein the substantially cylindrical shape comprises a plurality of spiral grooves defined along the circular outer diameter and extending along the longitudinal portion; and

an end portion comprising a spiral groove extending from the end portion partially along the longitudinal portion, wherein the spiral groove provides one or more mechanisms for attachment; and

a reel assembly for receiving the fish tape.

In setting forth a ground of rejection, the Office relies on Figure 5 (shown previously) and Prior Art Figure 1 of the instant case, which shows how an elongate flexible member may be stored in a reel (Action, page 2).

Applicants traverse the rejection of Claim 11 on the grounds that Tihon is non-analogous art. For the purposes of evaluating obviousness of claimed subject matter, the particular references relied upon must constitute "analogous art". *In re Clay*, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1058, 1060-61 (Fed. Cir. 1992). The art must be from the same field of endeavor, or be reasonably pertinent to the particular problem with which the inventor is involved. In the matter at hand, Tihon is directed to a self cleansing bladder drainage device. Tihon's device has channels for urine to drain to a reversibly detachable collection segment. Thus, Tihon is neither from the same field of endeavor nor is pertinent to the particular problem of using fish tape to fish wires and/or cables through an area that may not be accessible. Therefore, Tihon is non-analogous art, and any §103 rejection based on Tihon is improper. On at least this basis, the Applicant requests reconsideration and withdrawal of the stated § 103 rejections of Claim 11.

The evidence does not support a § 103 rejection because Tihon and the Prior Art Figure 1, whether considered alone or in combination, must teach or suggest all the elements of Claim 11. In particular, Tihon and the Prior Art Figure 1 do not teach or suggest "a circular outer

diameter”, “an end portion comprising a spiral groove extending from the end portion partially along the longitudinal portion, wherein the spiral groove provides one or more mechanisms for attachment; and a reel assembly for receiving the fish tape”, as recited in Claim 11. On at least this additional basis, the Applicant requests reconsideration and withdrawal of the stated §103 rejections of Claim 11.

Turning now to the stated motivation for combining Tihon and Prior Art Figure 1, the Office stated the motivation for providing a reel for the elongate member would have been obvious as “a convenient means of storing and dispensing the Tihon elongate member” (Action, pages 2-3). Applicant respectfully disagrees and submits that this motivation is not sound, because there is nothing in either of the references that would suggest this motivation. Additionally, “convenience” is too general as a motivation because it could cover almost any alteration contemplated of Tihon, and does not address why this specific proposed modification would have been obvious. Thus, this rejection is improper.

Furthermore, regarding the stated motivation for combining Tihon and Prior Art Figure 1, Tihon does not provide any motivation to combine its teachings with Prior Art Figure 1. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) MPEP §2143.01. First, Applicant submits that the Tihon device is not capable of being stored and dispensed in the reel of Prior Art Figure 1. The Tihon device has a tubular collection segment that will not fit into the reel. Additionally, modifying Tihon as proposed in the Action may defeat or destroy the stated purpose of Tihon. More specifically, storing and dispensing the

Tihon device would destroy Tihon's intended purpose as a bladder drainage device and may create bacteria growth and infections.

Neither Tihon nor Prior Art Figure 1 teach or suggest at least the foregoing features, whether considered alone or in combination. Additionally, Tihon is non-analogous art, relative to the claimed subject matter. Finally, Tihon and Prior Art Figure 1 are not properly combined under §103. Accordingly, Tihon and Prior Art Figure 1 do not support a §103 rejection of Claim 11. Applicant thus requests reconsideration and withdrawal of the stated rejection of Claim 11.


Claim 13 depends directly from independent Claim 11. Thus, the comments directed above to Claim 11 apply equally to Claim 13. Accordingly, Applicant requests reconsideration and withdrawal of the §103 rejections of Claims 11 and 13.

Conclusion

Applicant requests withdrawal of all pending claim rejections. Applicant respectfully requests reconsideration and prompt issuance of the present application.

Respectfully Submitted,

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